

Applicant: Virginia W. Cornish  
Serial No.: 10/705,644  
Filed: November 10, 2003  
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REMARKS

Claims 158-180. By this Amendment, applicant has canceled claims 173-176 without prejudice or disclaimer to applicant's right to pursue the subject matter of these claims in the future. In addition, applicant has amended claims 158, 169, and 177. Support for the amendments to claim 158 may be found in the specification as filed at, inter alia, page 24, line 32 to page 25, line 21; page 7, lines 2-3; and page 23, lines 27 to 34,; and Figs. 2, 13, and 19 which show binding of the DNA-binding domain upstream of the reporter gene. Claim 169 has been amended to italicize the organism names recited therein. Support for the amendments to claim 158 may be found in the specification as filed at, inter alia, page 24, line 32 to page 25, line 21; page 7, lines 2-3; and page 23, lines 27 to 34; and page 4, line 35 to page 5, line 25; and Figs. 2, 13, and 19 which show binding of the DNA-binding domain upstream of the reporter gene. Accordingly, applicant respectfully requests entry of this Amendment.

Interview with Examiner Robinson and Supervisory Examiner Nashed

Applicant thanks Examiners Hope Robinson and Nashaat Nashed for the January 18, 2008 telephonic interview with the undersigned. Applicant understands that the claim amendments agreed during the interview, as presented herein, are sufficient to overcome all of the outstanding rejections in November 14, 2007 Office Action. Applicant has hereinabove

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amended the claims consistent with this understanding of the January 18, 2008 telephonic interview.

#### Claims 173-180

In the November 14, 2007 Office Action the Examiner stated that claims 173-180 are withdrawn from further consideration as being drawn to a non-elected invention. The Examiner stated that the claims would have been subjected to a Restriction Requirement had they been presented in the application at the time of filing based on methods directed to a different end point with different method steps.

In response, applicant notes that claims 173-176 have been cancelled hereinabove without prejudice or disclaimer. In addition, applicant has hereinabove amended claim 177, on which claims 178-180 depend, to recite the features as discussed in the above-referenced January 18, 2008 telephonic interview. Applicant notes that, as amended, claim 177 is directed to the same end point as claim 135 and is in a Jespon format, the improvement being described therein. Accordingly, applicant requests that the Examiner consider claim 177, and claims 178-180 dependent thereon, in addition to the remaining pending claims.

#### Claim Objection

Claim 169 was objected to by the Examiner in the November 14, 2007 Office Action for not italicizing the organism names recited therein.

In order to expedite prosecution, and without conceding the correctness of the Examiner's position, applicant has

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hereinabove amended claim 169 to italicize the organism names recited therein. Accordingly, applicant understands this objection to be moot.

Claims Rejected Under 35 U.S.C. §112, First Paragraph (Enablement)

The Examiner rejected claims 158-172 under 35 U.S.C. §112, first paragraph, as not enabled by the specification.

In response, applicant respectfully traverses the Examiner's rejection. However, applicant has hereinabove amended claim 158, from which the remaining rejected claims depend, as agreed during the January 18, 2008 telephonic interview which overcomes this enablement rejection. Accordingly, applicant looks forward to the withdrawal of this ground of rejection.

Claims Rejected Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 158-172 under 35 U.S.C. §112, second paragraph, as allegedly failing to set forth the subject matter which applicant regards as her invention.

In response, applicant respectfully traverses the Examiner's rejection. However, applicant has hereinabove amended claim 158, from which the remaining rejected claims depend, as agreed during the January 18, 2008 telephonic interview which overcomes this second paragraph rejection. Accordingly, applicant looks forward to the withdrawal of this ground of rejection.

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The Examiner also rejected claims 171 and 172 under 35 U.S.C. §112, second paragraph, as allegedly presenting an improper Markush grouping.

In response, applicant respectfully traverses the Examiner's rejection. However, applicant has hereinabove amended claim 158, from which the remaining rejected claims depend, as agreed during the January 18, 2008 telephonic interview which overcomes this second paragraph rejection. Accordingly, applicant looks forward to the withdrawal of this ground of rejection. In addition, applicant notes that claims 171 and 172 in fact each properly limit multiple elements of claim 158 and as such are proper dependent claims. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection.

Claims Rejected Under 35 U.S.C. §102(b)

The Examiner rejected claims 158-160 under 35 U.S.C. §102(a) as anticipated by Lin et al., *J. Am. Chem. Soc.* 122:4247-4248 (2000).

In response, applicant respectfully traverses the Examiner's rejection. However, applicant has hereinabove amended claim 158, from which the remaining rejected claims depend, as agreed during the January 18, 2008 telephonic interview which overcomes this anticipation rejection. Accordingly, applicant looks forward to the withdrawal of this ground of rejection.

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SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

In accordance with the duty of disclosure under 37 C.F.R. §1.56, applicant directs the Examiner's attention to the following references listed on the attached substitute Form PTO-1449 (Exhibit A). Copies of references 1-3 are attached hereto as Exhibits 1-3, respectively.

- 1) Notice of Allowance issued November 13, 2007 in connection with U.S. Serial No. 10/614,625; (Exhibit 1)
- 2) Final Office Action issued October 16, 2007 in connection with U.S. Serial No. 10/056,874; (Exhibit 2)
- 3) Office Action issued October 1, 2007 in connection with U.S. Serial No. 10/512,497. (Exhibit 3)

Applicant requests that the Examiner review the above publication and patent applications and make them of record in the subject application. Applicant is submitting this Information Disclosure Statement under 37 C.F.R. §1.97(c)(2) and the undersigned hereby authorizes the U.S. Patent and Trademark Office to charge the amount of ONE HUNDRED EIGHTY DOLLARS (\$180.00) to Deposit Account No. 03-3125.

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No fee, apart from the authorized charge of \$180.00 for filing an Information Disclosure Statement, is deemed necessary in connection with the filing of this Amendment and Supplemental Information Disclosure Statement. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being transmitted by facsimile on this date to: 1-571-273-8300 Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22311-1450.	
<i>Gary J. Gershik</i> Gary J. Gershik Reg No. 39,992	<i>2/14/08</i> Date

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